

### **REMARKS**

Applicants thank the Examiner for the very thorough consideration given the present application. Claims 1-3, 5, and 7-34 are currently pending in this application. No new matter has been added by way of the present amendment. For instance, new claim 34 is supported by previously presented claim 6, now cancelled. The amendments to the claims are supported by, for example, pages 71-78. Accordingly, no new matter has been added.

At the outset, the present application is believed to be in condition for allowance. Entry of the accompanying amendment is requested under 37 C.F.R. §1.116, as the amendment does not raise any new issues which would require further search and/or consideration by the Examiner. Furthermore, Applicants request entry of this amendment in order to place the claims in better form for consideration on Appeal.

In view of the amendments and remarks herein, Applicants respectfully request that the Examiner withdraw all outstanding rejections and allow the currently pending claims.

### **Issues Under 35 U.S.C. 102(e)**

Claims 28-32 stand rejected under 35 U.S.C. 102(e) as being anticipated by Hattori et al. (U.S. 7,141,183) (hereinafter Hattori '183). Applicants respectfully traverse.

Applicants respectfully submit that the Examiner has failed to establish a *prima facie* case of anticipation. For anticipation under 35 U.S.C. §102, the reference must teach each and every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present. The fact that a certain result or characteristic may occur or be

present in the prior art is not sufficient to establish the inherency of that result or characteristic.

*In re Rijckaert*, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993).

Hattori '183 is directed to a **conductive elastomer composition** (emphasis added), comprising:

- a) a compound A1 composed of a thermoplastic resin or elastomer;
- b) a compound A2, composed of a crosslinkable rubber and/or crosslinkable thermoplastic elastomer, dispersed in compound A1; and
- c) an ionic-conductive-agent B containing a metal salt and a polyether-containing block copolymer resin (see, e.g., claim 1).

However, Hattori '183 does not explicitly or implicitly disclose a method of manufacturing a conductive member comprising the steps of: kneading or blending a salt capable of dissociating into cations and anions uniformly with a polymer comprising a first discontinuous polymer phase in which said salt capable of dissociating into cations and anions is preferentially distributed to form a compound or a mixture of said salt and said polymer; adding a polymer comprising a continuous polymer phase and a polymer comprising a second discontinuous polymer phase to said compound or said mixture; and kneading a mixture of said components to form a conductive polymer composition; and molding or forming said conductive polymer composition by heating said conductive polymer composition into whole or a part of said conductive member for use in an image-forming apparatus.

Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

**Double Patenting Issues**

Claims 1-3, 5 and 7-33 stand rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of Hattori '183. Applicants respectfully traverse.

As noted above, the claims of Hattori '183 are directed to a conductive elastomer composition comprising: a compound A1 composed of a thermoplastic resin or elastomer; a compound A2, composed of a crosslinkable rubber and/or crosslinkable thermoplastic elastomer, dispersed in compound A1; and an ionic-conductive-agent B containing a metal salt and a polyether-containing block copolymer resin (see, e.g., claim 1).

In stark contrast, the present claims are directed to a conductive member, rather than a conductive elastomer composition. For this reason alone, it is clear that the present claims are patentably distinct from the claims of Hattori '183.

Moreover, the present claims require, for example, a conductive layer comprising a continuous polymer phase and a discontinuous polymer phase which comprises a first discontinuous polymer phase and a second discontinuous polymer phase; and a salt capable of dissociating into cations and anions, preferentially distributed in said first discontinuous polymer phase, and minimally distributed in said second discontinuous polymer phase and said continuous polymer phase. The present claims further require that the electrical resistance of said first discontinuous polymer phase is lower than an electrical resistance of said continuous

polymer phase, and the electrical resistance of the continuous polymer phase is lower than the electrical resistance of the second discontinuous polymer phase.

These limitations are not in the claims of Hattori '183. Moreover, contrary to the Examiner's assertion, it would not have been obvious to one skilled in the art to modify the present claims as proposed by the Examiner.

Clearly, the present claims are patentably distinct from the claims of Hattori '183. Accordingly, reconsideration and withdrawal of this rejection are respectfully requested.

### **Conclusion**

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and objections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Vanessa Perez-Ramos, Reg. No. 61,158, at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

By 

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